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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.												
10/058,122	01/29/2002	Philip B. Sample	00167-455001	3500												
7590 JOEL R. PETROW Smith & Nephew, Inc. 1450 Brooks Road Memphis, TN 38116		08/22/2007	<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">SHAFFER, RICHARD R</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>3733</td><td></td></tr><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>08/22/2007</td><td>PAPER</td></tr></table>		EXAMINER		SHAFFER, RICHARD R		ART UNIT	PAPER NUMBER	3733		MAIL DATE	DELIVERY MODE	08/22/2007	PAPER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/058,122

Applicant(s)

SAMPLE, PHILIP B.

Examiner

Richard R. Shaffer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 0207.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 and 41-78 is/are pending in the application.
- 4a) Of the above claim(s) 4,7-10,20,22,27-36,38 and 76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,11-19,21,23-26,37,41-75,77 and 78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: WO 92/08416.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I in the reply filed on May 18th, 2007 is acknowledged. Claims 27-30 and 33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 18th, 2007.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 43, 47-75 and 78 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 43 and 47 recite the limitation, "the off-axis movement **alone** being capable of **acting to cut tissue**." The off-axis movement is not the only force causing cutting of the tissue. For example, one would have to hold the device against tissue. Applicant further repeatedly states how the device must shear the tissue between the cutter and a surface of the instrument, etc. Therefore, it is clear it is "not alone" and is merely one of several components involved in cutting tissue.

All dependent claims of 43 and 47 are rejected for containing new matter through dependency.

Claim 72 recites the limitation, "the first shaft protruding from a **first surface of the cutter** and the second shaft protruding from a **second surface of the cutter ...**" Applicant's cutter has been claimed, defined and shown as being spherical in shape. There are no "surfaces" for one to distinguish on a sphere. There is only one surface. Therefore by applicant claiming the cutter having two outer surfaces, applicant has claimed a device that has was not disclosed in the specification, drawings or claims as originally filed. All dependent claims of claim 72 are rejected for containing new matter through dependency.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 6, 11-19, 21, 23-26, 37, 41-75, 77 and 78 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamlin et al (WO 92/08416).

Hamlin et al disclose (**Figures 3-12**) a cutting instrument comprising: an outer member (**46, 30 and 22 together**) having a terminal end housing a cutter (**62**) with comprises a spherical portion; the terminal end is spherical and further defines an opening (**50**); the cutter (**62**) having an opening (**64**) and a circumferentially located plurality of teeth (**66**); the outer member includes a first and second arc-shaped

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chambers to receive shafts (enlarge portion **56** is the second shaft and the portion containing the plurality of teeth is the first shaft) of the cutter (**62**); an inner member (**70**) having a hollow passage capable of removing cut disuse through it; the inner member having a plurality of teeth (**78**) for engaging the teeth (**66**) at a perpendicular angle (**Page 3, Lines 28-33**); and the inner member will rotate about a fixed axis causing the cutter to rotate about a perpendicular axis. The device of Hamlin et al is inherently capable of performing the intended functions of applicant's claimed device as well as anticipating applicant's product-by-process claims since applicant must make a showing that one would not be able to form the device of Hamlin et al in the manners claimed to overcome anticipation.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Richard Shaffer
August 18th, 2007



CRIS RODRIGUEZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700